

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB

NOV. 23, 99

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re D'Oro Cosméticos Internacional, S.A. de C.V.

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Serial No. 74/642,431

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Leslie Bertagnolli and John A. Bacon of Baker & McKenzie for  
D'Oro Cosméticos Internacional, S.A. de C.V.

Lynn A. Luthey, Trademark Examining Attorney, Law Office 106  
(Mary I. Sparrow, Managing Attorney).

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Before Simms, Hohein and Bucher, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

D'Oro Cosméticos Internacional, S.A. de C.V. has filed  
an application to register the mark "D'GOLD," in the stylized  
format reproduced below,

for "cosmetics, namely skin lotions, mascara, lipstick, nail hardeners, nail enamels, nail polishes, makeup, blush, eye shadows, deodorants for personal use, and hair shampoos".<sup>1</sup>

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its goods, so resembles each of the following marks, which are owned by the same registrant, as to be likely to cause confusion, mistake or deception:

(i) "PARFUM D'ORO," which is registered in the stylized format shown below,

for "perfume, essential oils for personal use, skin soaps, hair bleaching preparations, all purpose cleaning, polishing, scouring and abrasive preparations, hair lotions, [and] dentifrices";<sup>2</sup> and

(ii) "D'ORO U.S.A.," which is registered in the manner illustrated below,

for "nail polish, nail hardener, [and] nail conditioner".<sup>3</sup>

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<sup>1</sup> Ser. No. 74/642,431, filed on March 6, 1995, which alleges a bona fide intention to use the mark in commerce and also seeks registration on the basis of Mexican Reg. No. 426210, issued on August 3, 1992.

<sup>2</sup> Reg. No. 1,912,933, issued on August 22, 1995, which sets forth dates of first use of December 14, 1993. The registration states that: "The translation of the mark 'PARFUM D'ORO' in [the] Italian language means 'perfume of gold'" and that the term "PARFUM" is disclaimed.

<sup>3</sup> Reg. No. 1,945,141, issued on January 3, 1996, which sets forth dates of first use of April 15, 1986. The registration indicates that: "The translation of the mark 'D'ORO' in [the] Italian language means 'gold'" and that the term "U.S.A." is disclaimed.

Applicant has appealed. Briefs have been filed,<sup>4</sup> but an oral hearing was not requested. We affirm the refusal to register.

As a preliminary matter, we observe that the goods of applicant and registrant are identical in part (nail hardeners and nail polishes) and are otherwise closely related items of cosmetics and personal care products. Respondent, we note, does not contend otherwise and it is clear that, if such identical and closely related goods were to be marketed under the same or similar marks, confusion as to the source or sponsorship thereof would be likely to occur.

Applicant contends, however, that confusion is not likely because, when considered in their entirety:

[T]he only similarities [sic] between  
the applied for mark, D'GOLD, and the cited

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<sup>4</sup> It is noted that applicant, for the first time, has attached copies from a commercial database of several third-party registrations to its appeal brief. Although the Examining Attorney has not objected to such evidence on the grounds that it is untimely under Trademark Rule 2.142(d) and is otherwise not properly of record, neither has she treated the evidence as being of record by discussing it in her brief. In particular, Trademark Rule 2.142(d) provides that "[t]he record in the application should be complete prior to the filing of an appeal" and that the Board "will ordinarily not consider additional evidence filed ... after the appeal is filed." Moreover, even if timely filed, in order to make information regarding third-party registrations properly of record, it is necessary to submit either copies of the actual registrations or the electronic equivalents thereof, i.e., printouts of the registrations which have been taken from the Patent and Trademark Office's own computerized database. See, e.g., In re Consolidated Cigar Corp., 35 USPQ2d 1290, 1292 (TTAB 1995) at n. 3; In re Smith & Mehaffey, 31 USPQ2d 1531, 1532 (TTAB 1994) at n. 3 and In re Melville Corp., 18 USPQ2d 1386, 1388-89 (TTAB 1991) at n. 2. Nevertheless, and in any event, we observe that inasmuch as none of the third-party registrations which applicant attached to its brief is for a mark which is as similar to applicant's mark as are the marks of the cited registrations, such evidence would make no difference in the disposition of this appeal.

registrations [for the marks,] PARFUM D'ORO and D'ORO USA, is that "ORO" is Italian for "gold". When the other components of the [marks in the] cited registrations, namely "PARFUM" and "USA" are considered, ... consumers will not automatically assume that products bearing the respective marks originate from the same source. It is applicant's contention that differences in visual impression and sound between the applied for mark and the [marks in the] cited registrations far outweigh the literal meaning of the words, so that the relevant consumer will not be confused as to the origin of these goods.

Applicant further maintains that, while "[t]he doctrine of foreign equivalents can be appropriately applied in determining likelihood of confusion," this is not such a case because "it is unreasonable to think that consumers will associate D'GOLD with the Italian word for "gold" ("ORO"), compare the marks as a whole and then determine that they are confused as to origin of the products." In particular, applicant asserts that:

While Appellant does not suggest that Italian is not a significant world language, the potential for confusion between an English word and an Italian foreign equivalent mark is not at the same level as the potential for confusion between an English word mark and a trademark in the French or Spanish language. These languages are commonly taught in U.S. schools and the number of average consumers familiar with French or Spanish far outweigh the average consumers who speak or understand Italian.

We agree with the Examining Attorney, however, that confusion is likely. As the Examining Attorney accurately points out:

The [respective] marks are similar in appearance. The [applicant's] ... mark and the cited registered marks contain the identical lettering, namely a stylized letter

"D" followed by an apostrophe, and the word "ORO" or "GOLD" The highly stylized and capitalized letter "D" creates as strong and prominent visual impression that dominates the mark[s]. The part of the mark following the "D", namely "GOLD"[,] in applicant's mark ... is in smaller capital letters, as is the registrant's "ORO". Therefore, the marks create the same visual impression, and a consumer could be confused as to the source of the goods.

Such is particularly the case inasmuch the generic term "PARFUM" in respondent's "PARFUM D'ORO" mark and the geographical term "U.S.A." in its "D'ORO U.S.A." mark constitute subordinate matter which, in light of the descriptiveness thereof, is insufficient to distinguish registrant's marks from applicant's "D'GOLD" mark.

The Examining Attorney further contends that the respective marks "have the same meaning under the doctrine of foreign equivalents," arguing that (footnotes omitted):<sup>5</sup>

The term D'ORO in the registrant's marks means "gold" or "of gold" in Italian according to the translation[s] on the registrations. Also, the term ORO means "gold" in Spanish. .... It is noted that the applicant is a Mexican corporation and ORO is a Spanish word. The translation of ORO is "gold" and the applicant's mark D'GOLD is the foreign equivalent of the registrant's marks D'ORO.

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<sup>5</sup> The Examining Attorney has requested that the Board take judicial notice of dictionary definitions, copies of which are attached to her brief, which show that "oro" is defined in the Zanichelli New College Italian & English Dictionary (1990) at 923 and in Cassell's Spanish-English English-Spanish Dictionary (rev. ed. 1978) at 447 as meaning "gold". Such request is approved inasmuch as it is settled that the Board may properly take judicial notice of dictionary definitions. See, e.g., Hancock v. American Steel & Wire Co. of New Jersey, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953) and University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

The Examining Attorney insists, in view thereof, that "[c]onsumers seeing the mark, D'GOLD, in stylized form used on various types of cosmetics, and the registered marks PARFUMS [sic] D'ORO and D'ORO U.S.A., in stylized form, also on various types of cosmetics, are likely to mistakenly conclude that the goods are related and originate from a common source."

Under the doctrine of foreign equivalents, marks which consist of or contain foreign words from modern languages are translated into English to, inter alia, ascertain whether they are confusingly similar to English word marks. The test is whether, to those American buyers familiar with the foreign language, the word would denote its English equivalent. The rationale behind the rule is that a foreign word familiar to an appreciable segment of American purchasers may be confusingly similar to its English equivalent, or vice versa. See 3 J. Thomas McCarthy, McCarthy on Trademarks & Unfair Competition, Sections 23:36--23:38 (4th ed. 1999). See also In re Perez, 21 USPQ2d 1075 (TTAB 1991); In re American Safety Razor Co., 2 USPQ2d 1459 (TTAB 1987); and In re Ithaca Industries, Inc., 230 USPQ 702 (TTAB 1986). In the present case, however, the designation "D'GOLD" in applicant's mark is not, strictly speaking, an English word. It is instead a hybrid composed of the Italian or Spanish term "D'," meaning "of," and the English word "GOLD".

We thus disagree with the Examining Attorney that the designation "D'GOLD" in applicant's mark is the foreign equivalent of the dominant and distinguishing term "D'ORO" in

each of registrant's marks. Nevertheless, it is still the case that, due to the identity in meaning between the English word "GOLD" and the Spanish and Italian word "ORO," purchasers and prospective customers for cosmetics and other closely related personal care products who are acquainted with such languages would be likely to believe, in view of the substantial overall similarities noted previously in the appearance of the respective marks, that the goods share the same origin or affiliation. To such consumers, who constitute a not insignificant segment of the purchasing public in the United States, applicant's mark "D'GOLD" and the source-signifying term "D'ORO" in registrant's marks "PARFUM D'ORO" and "D'ORO U.S.A." would convey essentially the same connotation and, given the virtual identity in the overall stylization of the respective marks, including the prominently displayed script letter "D," the marks would project the same commercial impression when considered in their entireties.

We accordingly conclude that applicant's stylized "D'GOLD" mark, when used in connection with nail polishes, nail hardeners and the other cosmetics set forth in its application, would be likely to cause confusion as to source or sponsorship with the contemporaneous use by registrant of its stylized "PARFUM D'ORO" and "D'ORO U.S.A." marks for nail polish, nail hardener and other closely related personal care products listed in the cited registrations.

**Decision:** The refusal under Section 2(d) is affirmed.

R. L. Simms

Ser. No. 74/642,431

G. D. Hohein

D. E. Bucher  
Administrative Trademark Judges,  
Trademark Trial and Appeal Board